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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,094	08/04/2003	Harold Little	HL-1-js-mv	5878
7590	11/07/2005		EXAMINER	
Michael I. Kroll 171 Stillwell Lane Syosset, NY 11791			SPAHN, GAY	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/634,094

Applicant(s)

LITTLE, HAROLD

Examiner

Gay Ann Spahn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2005 and 16 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) 4-11, 13, 16, 17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 18 is/are rejected.
- 7) ☒ Claim(s) 2, 3 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Allowable Subject Matter*

Claim 20 would be allowable if rewritten or amended to overcome the claim objections set forth in this Office action.

Claims 2 and 3 would be allowable if rewritten to overcome the claim objections as set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### *Drawings*

The drawings were received on 20 July 2005. These drawings are approved by the Examiner.

### *Claim Objections*

Claims 2, 3, and 20 objected to because of the following informalities:

(1) **claim 2**, line 4, the recitation of "a downwardly extending wall from . . . " seems to be missing some words between the word "wall" and the word "from" and the examiner suggests inserting the words --extending downwardly-- between the word "wall" and "from" for clarity;

(2) **claim 2**, line 8, the recitation of "said downwardly extending wall" is confusing because it is not clear if it is referring back to the "downwardly extending wall" in line 4 or line 6 and therefore, the examiner suggests amending the "downwardly extending

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wall" in line 4 to --a first downwardly extending wall-- and the "downwardly extending wall" in line 6 to --a second downwardly extending wall-- and "said downwardly extending wall" in line 8 to --said second downwardly extending wall--;

(3) **claim 2**, line 6, the word --to-- should be inserted after the word "adjacent" for clarity;

(4) **claim 3**, line 6, there is no antecedent basis for "the ornamental structures" since claim 1, lines 5 and 9, recite "seasonal decorations" and therefore, it is suggested that "the ornamental structures" be changed to --the seasonal decorations--;

(5) **claim 20**, line 3, the word --to-- should be inserted after the word "adjacent" for clarity;

(6) **claim 20**, lines 2-4, the examiner notes that there appear to be some words missing between the recitation of "a gutter mounted on an exterior surface of a building having at least one support member extending from and adjacent an upper end of an outer wall of said gutter" in lines 2-3 and the recitation of "to said exterior surface for supporting said gutter on said exterior surface of said building" in line 4;

(7) **claim 20**, line 11, the word --first-- should be inserted after the word "said" for proper antecedent basis and the words --extending downwardly-- should be inserted after the second occurrence of the word "wall" for proper readability;

(8) **claim 20**, line 13, the recitation of "said second downwardly wall" should be changed to --said second downwardly extending wall-- for proper antecedent basis; and

(9) **claim 20**, line 14, the recitation of "said flange and support member having aligned recesses to accommodate . . ." should be changed to something like --said

flange having a recess and said support member of said gutter having a recess, the recess of the flange being aligned with the recess of the support member of the gutter to accommodate . . .--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by**

**Kinderman (U.S. Patent No. 6,076,938).**

**As to claim 1**, Kinderman discloses a gutter mounting apparatus (10) comprising:

a) a gutter (50) mounted on an exterior surface of a building having a support for attaching said gutter to said exterior surface of said building (see Fig. 1);

b) a permanent member (35, 19, 13) mounted on said gutter (50) adapted to support a dismountable member (25) for supporting seasonal decorations (33), said permanent member (35, 19, 13) including a solid rod (13) suspended on the outside of and spaced from (see Fig. 6) said gutter (50);

c) said dismountable member (25) adapted to slide or snap (via peg 23) onto said rod (13); and

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d) hooks (27) spaced on an external surface of said dismountable member (25) for suspending said seasonal decorations (33).

**Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Blanton (U.S. Patent No. 6,076,938).**

As to claim 18, Blanton discloses a method for mounting ornamental structures (A) on a gutter (G) attached to an outer wall of a building comprising the steps of:

a) securing a permanent member (40 in Fig. 14) to said gutter (G), the permanent member (40) having a rod (44) extending along a length thereof on an outside of and spaced from (by the thickness of 43) an outer wall (E, W) of said gutter (G);

b) selectively connecting ornamental structures (A) to a dismountable member (22), the dismountable member (22) being a tube (23) including a channel (inside of 23) having a diameter and length corresponding with a diameter and length of the rod (44) of the permanent member (40);

(c) aligning the dismountable member (22) with the permanent member (40); and

d) inserting the rod (44) within the channel (inside of 23) of the tube (23) thereby mounting the ornamental structures (A) on said gutter (G).

The examiner notes that the length of the channel (inside of 23) of Blanton is deemed to meet the claim language of "corresponds with" the length of the rod in the sense that it runs along side it (not in the sense that it is the same length as it).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blanton (U.S. Patent No. 6,076,938) in view of Reimer (U.S. Patent No. 4,888,671).**

**As to claim 1, Blanton discloses a gutter mounting apparatus (see Fig. 14) comprising:**

a) a gutter (G) mounted on an exterior surface of a building (the house to which the gutter (G) is attached) having a support for attaching said gutter to said exterior surface of said building;

b) a permanent member (40) mounted on said gutter (G) adapted to support a dismountable member (23, Figs. 7 and 8) for supporting seasonal decorations (A), said permanent member (40) including a rod (44) suspended on the outside of and spaced from (by plate (12) on either side of rod (44)) said gutter (G);

c) said dismountable member (22) adapted to slide or snap onto said rod (44);  
and

d) hooks (24) spaced on an external surface of said dismountable member (22) for suspending said seasonal decorations (A).

The examiner notes that the word "suspend" is defined in Merriam-Webster's Collegiate Dictionary (Tenth Edition, Copyright 1997, published by Merriam-Webster,

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Incorporated, Springfield, Massachusetts) as “to hang so as to be free on all sides except at the point of support.” The examiner’s position is that “hang” down not have to mean “hang down” and that the rod (44) of Blanton is supported only at reduced neck portion (45) and therefore, meets the claim limitation of “suspended”.

Blanton fails to explicitly disclose that the rod is a solid rod.

Reimer discloses an ornamental strip light mounting means having a solid rod (12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gutter mounting apparatus of Blanton to make the rod (13) of Blanton a solid rod as taught by Reimer in order to make the rod sturdier to withstand possible buckling or crushing thereof should the dismountable member grip the rod too tightly.

### ***Response to Arguments***

Applicant's arguments with respect to amended independent claim 18 in an Amendment filed on 20 July 2005 and in a Supplemental Amendment filed on 16 August 2005 have been fully considered but they are not persuasive. Claim 18 has not been amended to recite that the rod is solid and it is the examiner’s position that amended claim 18 is still not distinguish from Blanton for the reasons stated above with respect to the rejection of claim 18 and because the examiner believes that Blanton discloses that his rod (13) is “spaced from” the gutter by the distance of the thickness of flat lateral side portions (12).



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Applicant's arguments with respect to independent claim 1 have been considered, but are moot in view of the new grounds of rejection (i.e., 35 U.S.C. § 102(b) rejection of claim 1 based upon Kinderman as set forth above and 35 U.S.C. § 103(a) rejection of claim 1 based upon Blanton in view of Reimer as set forth above).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-

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7731. The examiner can normally be reached on Monday through Thursday, 8:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (571)-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gay Ann Spahn, Patent Examiner  
October 11, 2005



**MICHAEL SAFAVI  
PRIMARY EXAMINER  
ART UNIT 354**